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## **I. STATUS OF CLAIMS**

Claims 1-48 are pending.

Claims 13-21 are objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim.

Claims 1-22, 27-41, 43, and 46-48 stand rejected under 35 U.S.C. §102(b) as being anticipated by McElhatton, et al. (U.S. Patent No. 3,860,796) ("McElhatton"). *See Examiner's Office Action*, p. 2 (6 February 2008).

Claims 24-26, 42, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McElhatton in view of Waldron, et al. (U.S. Patent No. 5,296,691) ("Waldron") *See Examiner's Office Action*, p. 4 (6 February 2008).

## **II. CLAIM OBJECTIONS**

Claims 13-21 are objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. Claims 13-21 have been rewritten in independent form.

## **III. ISSUES TO BE REVIEWED**

The issues in this response relate to whether the art of record establishes a *prima facie* case of the unpatentability of Applicant's Claims 1-48. For reasons set forth elsewhere herein, Applicant respectfully asserts that the art of record does not establish a *prima facie* case of the unpatentability of any pending claim. Accordingly, Applicant respectfully requests that Examiner hold all pending Claims 1-48 allowable for at least the reasons described herein, and issue a Notice of Allowance on same.

## **IV. ARGUMENT: ART OF RECORD DOES NOT ESTABLISH *PRIMA FACIE* CASE OF UNPATENTABILITY IN VIEW OF CITED ART OF RECORD**

Examiner has stated "Claims 1-22, 27-41, 43, and 46-48 are rejected under 35 U.S.C. 102(e) as being anticipated by McElhatton et al. (US 6,701,652)." *See Examiner's Office Action*, p. 2 (20 August 2008). Examiner has also stated "Claims 24-26, 42, and 44 are rejected under 35

U.S.C. 103(a) as being unpatentable over McElhatton in view of Waldron et al. (US 5,296,691)." See *Examiner's Office Action*, p. 4 (20 August 2008).

In response, Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability as set forth below, the art of record does not establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that the art of record does not recite the text of Applicant's claims at issue, and hence fails to establish a *prima facie* case of unpatentability. Accordingly, Applicant respectfully requests that the Examiner withdraw his rejections and hold all claims to be allowable over the art of record.

#### **A. MPEP Standards for Patentability<sup>1</sup>**

The MPEP states as follows: "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." MPEP § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)); *In Re Glaug* 283 F.3d 1335, 62 USPQ2d 1151 (Fed. Cir. 2002) ("During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent."). Accordingly, unless and until an examiner presents evidence establishing *prima facie* unpatentability, an applicant is entitled to a patent on all claims presented for examination.

#### **1. MPEP Standards for Determining Anticipation**

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); MPEP § 2107 (citing *In re Oetiker*, 977

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<sup>1</sup> Applicant is aware that Examiner is familiar with the MPEP standards. Applicant is merely setting forth the MPEP standards to serve as a framework for Applicant's arguments following and to ensure a complete written record is established. Should Examiner disagree with Applicant's characterization of the MPEP standards, Applicant respectfully requests correction.

F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability...."). Failure of an examiner to meet this burden entitles an applicant to a patent. *Id.* ("[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent").

The MPEP indicates that in order for an examiner to establish a *prima facie* case of anticipation of an applicant's claim, the examiner must first interpret the claim,<sup>2</sup> and thereafter show that the cited prior art discloses the same elements, in the same arrangement, as the elements of the claim which the examiner asserts is anticipated. More specifically, the MPEP states that "[a] claim is anticipated *only if each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim. . . . The elements must be arranged as required by the claim . . . ." *MPEP* § 2131 (emphasis added). Consequently, under the guidelines of the MPEP set forth above, if there is *any* substantial difference between the prior art cited by an examiner and an applicant's claim which the examiner asserts is rendered anticipated by the prior art, the prior art does NOT establish a *prima facie* case of anticipation and, barring other rejections, the applicant is entitled to a patent on such claim.

## **2. MPEP Standards for Determining Obviousness**

"[T]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."<sup>3</sup> *MPEP* § 2142. The MPEP indicates that in order for an examiner to establish a *prima facie* case that an invention, as defined by a claim at issue, is obvious, the examiner must (1) interpret the claim at issue; (2) define one or more prior art reference components relevant to the claim at issue; (3) ascertain the differences between the one or more

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<sup>2</sup> With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow, in light of the specification, when read by one skilled in the art with which the claimed invention is most closely connected. *MPEP* § 2111.

<sup>3</sup> An invention, as embodied in the claims, is rendered obvious if an examiner concludes that although the claimed invention is not identically disclosed or described in a reference, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *MPEP* § 2141 (citing 35 U.S.C. § 103).

prior art reference components and the elements of the claim at issue; and (4) adduce objective evidence which establishes, under a preponderance of the evidence standard, a teaching to modify the teachings of the prior art reference components such that the prior art reference components can be used to construct a device substantially equivalent to the claim at issue. This last step generally encompasses two sub-steps: (1) adducement of objective evidence teaching how to modify the prior art components to achieve the individual elements of the claim at issue; and (2) adducement of objective evidence teaching how to combine the modified individual components such that the claim at issue, as a whole, is achieved. *MPEP* § 2141; *MPEP* § 2143. Each of these forgoing elements is further defined within the *MPEP*. *Id.*

This requirement has been explained recently by the Supreme Court in *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 (2007) which noted that such a rejection requires "some articulated reasoning ... to support the legal conclusion of obviousness." As stated by the Court, obviousness can be established where "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, ***this analysis should be made explicit.***" (*emphasis added*) See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.')." *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 at 1741.

As further described by the Court "[A] patent composed of several elements is ***not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.*** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 at 1741.



**a) Interpreting a Claim at Issue**

With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow when read by one skilled in the art with which the claimed invention is most closely connected. In practice, this is achieved by giving each of the terms in the claim the "plain meaning" of the terms as such would be understood by those having ordinary skill in the art, and if portions of the claim have no "plain meaning" within the art, or are ambiguous as used in a claim, then the examiner is to consult the specification for clarification. *MPEP* § 2111.

**b) Definition of One or More Prior Art Reference Components Relevant to the Claim at Issue**

Once the claim at issue has been properly interpreted, the next step is the definition of one or more prior art reference components (*e.g.*, electrical, mechanical, or other components set forth in a prior art reference) relevant to the properly interpreted claim at issue. With respect to the definition of one or more prior art reference components relevant to the claim at issue, the MPEP defines three proper sources of such prior art reference components, with the further requirement that each such source must have been extant at the time of invention to be considered relevant. These three sources are as follows: patents as defined by 35 U.S.C. § 102, printed publications as defined by 35 U.S.C. § 102, and information (*e.g.*, scientific principles) deemed to be "well known in the art"<sup>4</sup> as defined under 35 U.S.C. § 102. *MPEP* § 2141; *MPEP* § 2144.

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<sup>4</sup> The fact that information deemed to be "well known in the art" can serve as a proper source of prior art reference components seems to open the door to subjectivity, but such is not the case. As a remedy to this potential problem, *MPEP* § 2144.03 states that if an examiner asserts that his position is derived from and/or is supported by a teaching or suggestion that is alleged to have been "well known in the art," and that if an applicant traverses such an assertion (that something was "well known within the art"), the examiner must cite a reference in support of his or her position. The same MPEP section also states that when a rejection is based on facts within the personal knowledge of an examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. *Id.* Thus, all sources of prior art reference components must be objectively verifiable.

**c)      Ascertainment of Differences between Prior Art Reference  
Components and Claim at Issue; Teaching to Modify and/or  
Combine Prior Art Reference Components to Remedy Those  
Differences in Order to Achieve Recitations of Claim at Issue**

With one or more prior art components so defined and drawn from the proper prior art sources, the differences between the one or more prior art reference components and the elements of the claim at issue are to be ascertained. Thereafter, in order to establish a case of *prima facie* obviousness, an examiner must set forth a rationale, supported by objective evidence<sup>5</sup> sufficient to demonstrate under a preponderance of the evidence standard, that in the prior art extant at the time of invention there was a teaching to modify and/or combine the one or more prior art reference components to construct a device practicably equivalent to the claim at issue.

The preferable evidence relied upon is an express teaching to modify/combine within the properly defined objectively verifiable sources of prior art. In the absence of such express teaching, an examiner may attempt to establish a rationale to support a finding of such teaching reasoned from, or based upon, express teachings taken from the defined proper sources of such evidence (*i.e.*, properly defined objectively verifiable sources of prior art). *MPEP* § 2144; *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The MPEP recognizes the pitfalls associated with the tendency to subconsciously use impermissible "hindsight" when an examiner attempts to establish such a rationale. The MPEP has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that:

under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information,<sup>6</sup> the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of an Applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon an Applicant's disclosure is often difficult to avoid due to

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<sup>5</sup> The proper sources of the objective evidence supporting the rationale are the defined proper sources of prior art reference components, discussed above, with the addition of factually similar legal precedent. *MPEP* § 2144.

<sup>6</sup> "Factual information" is information actually existing or occurring, as distinguished from mere supposition or opinion. *Black's Law Dictionary* 532 (5th ed. 1979).

the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

*MPEP* § 2142 (emphasis added). Thus, if the only objective evidence of such teaching to modify and/or combine prior art reference components is an applicant's disclosure, no evidence of such teaching exists.<sup>7</sup>

The second rule is that if an examiner attempts to rely on some advantage or expected beneficial result that would have been produced by a modification and/or combination of the prior art reference components as evidence to support a rationale to establish such teachings to modify and/or combine prior art reference components, the *MPEP* requires that such advantage or expected beneficial result be objectively verifiable teachings present in the acceptable sources of prior art (or drawn from a convincing line of reasoning based on objectively verifiable established scientific principles or teachings). *MPEP* § 2144. Thus, as a guide to avoid the use of impermissible hindsight, these rules from the *MPEP* make clear that absent some objective evidence, sufficient to persuade under a preponderance of the evidence standard, no teaching of such modification and/or combination exists.<sup>8</sup>

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<sup>7</sup> An applicant may argue that an examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *MPEP* § 2145(X)(A) (emphasis added).

<sup>8</sup> *In Re Sang Su Lee* 277 F.3d 1338 (Fed. Cir. 2002) ("When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.") *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors). "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan,

**B. Technical Material Cited by Examiner Does Not Show or Suggest the Text of Independent Claim 1 and Dependent Claims 2-12 as Presented Herein; Notice of Allowance of Same Respectfully Requested**

**1. Independent Claim 1**

Independent Claim 1 recites as follows:

"An item comprising:

an outer part including at least one outer material that is substantially opaque to visible light; and

an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of

- (1) a substantially empty cavity in the at least one outer material, or
- (2) at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light."

As shown following, Examiner is interpreting McElhatton to "teach" at least a portion of the text of Independent Claim 1, but has not provided any objectively verifiable evidence supporting his interpretation.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 1 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 1 and Issue a Notice of Allowability for same.

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with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.")).

a) **Examiner is Interpreting McElhatton to "Teach" the Text of Independent Claim 1, But Does Not Support His Interpretation, Therefore The Examiner Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim**

As set forth above, Independent Claim 1 recites as follows: "An item comprising: (a) an outer part including at least one outer material that is substantially opaque to visible light; and (b) an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light." <sup>9</sup>

With respect to Independent Claim 1, Examiner has stated "McElhatton teaches an item comprising an outer part including at least one outer material (substrate 22) that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration (configuration of inks areas 46 and gap regions 48) corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of a substantially empty cavity in the at least one outer material, or at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light (col. 2, lines 27-30 and col. 3, lines 30-34)." *See Examiner's Office Action*, pp. 2-3 (20 August 2008). Applicant respectfully disagrees and traverses the rejection.

(1) **Examiner Has Put Forth No Evidence Supporting His Interpretation That McElhatton "Teaches" Recitations of Independent Claim 1**

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<sup>9</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

Applicant respectfully points out that Applicant has reviewed the portions of McElhatton identified by Examiner, and so far as Applicant can discern, the Examiner-cited portions of McElhatton do not recite the text of Applicant's Independent Claim 1. Rather, the relevant portions of McElhatton recite as follows:

FIG. 1 shows an emblem 20 having a substrate 22 with a first or frontside 24 facing upwardly, and an opposite second or backside 26 facing downwardly. An ink pattern 28, FIG. 2, is printed on second or backside 26 to provide graphics, to be described. A transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23 preferably of polycarbonate, acrylic or styrene, preferably having a thickness of 0.005 to 0.007 inch.

Ink pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween. Ink regions 54 of ink layer 32 are in the noted second set of gap regions 56. Ink regions 52 of ink layer 31 are in the noted third set of gap regions 58. Ink regions 52 and 54 of each of ink layers 31 and 32 are in the first noted set of gap regions 48, FIG. 14. The substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15. Ink layer 32 has differing depths in base layer 23, including a first depth at ink areas 46, and a second different depth at gap regions 48. Base layer 23 has differing depths in molded transparent layer 30, including a first depth at the noted first depth of ink layer 32 at ink areas 46, and a second depth at the noted second depth of ink layer 32 at gap regions 48.

The differing depths provide embossed 3-D graphics, which are encapsulated by molded transparent layer 30 and viewable through the latter from above, FIGS. 1, 10.

This universal application of mold tooling is simple and cost effective. The embossed 3-D graphic is viewable from above in FIGS. 1, 10, 15, 16, 17, through transparent substrate 60, if used, and through molded transparent layer 30.

*See Detailed Description McElhatton, col. 1, lines 48-57; col. 2, lines 6-23, lines 27-30; and col. 3, lines 30-34.*

As can be seen from the foregoing, the examiner-identified portions of McElhatton do not recite the text of clauses (a) – (b) as recited in Independent Claim 1. For instance, clause (a) recites "an outer part including at least one outer material that is substantially opaque to visible light." Emphasis added. Nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[s]ubstrate 22, FIG. 3, is provided by a thin film transparent base layer 23 " (McElhatton, col. 1, lines 54-55). Clause (b) recites "an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light." Emphasis added. Similarly, nowhere in McElhatton is there a recitation of this clause. Rather, col. 2, lines 36-46 recite "[i]nk pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween."

Applicant has reviewed the Examiner cited portions of McElhatton and is unable to locate a recitation of clauses (a) – (b) of Claim 1. Applicant further respectfully points out that the Examiner has provided no evidence or reason as to why the text of McElhatton should be interpreted to teach clauses (a) – (b) of Independent Claim 1 as the Examiner alleges.

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as teaching clauses (a) – (b) of Independent Claim 1.

With respect to Examiner assertions regarding the teachings of McElhatton, Applicant demonstrated above that the express recitations of McElhatton are not as Examiner alleges, and that Examiner has provided no evidence – let alone the preponderance of the evidence required -- to support Examiner assertions as to the factual conclusion as to what McElhatton “teaches.” Accordingly, Applicant respectfully points out that in view of the foregoing, Examiner has presented no evidence that McElhatton teaches as asserted by Examiner. In addition, Applicant respectfully points out that even if Examiner’s assertions regarding the teachings of McElhatton were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of McElhatton to the actual express language of Clauses [a] - [c] of Applicant’s

Independent Claim 1. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

**(2) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight; Applicant Requests Issuance of Notice of Allowability**

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as "teaching" something related to Clause [a] and/or Clause [b] of Independent Claim 1. Applicant respectfully points out that the Applicant's Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of McElhatton as set forth, it follows that Examiner is interpreting McElhatton through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding McElhatton are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner "teaches," Applicant infers that the Examiner is relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." *See, e.g., MPEP S 2144.03(C), If Applicant Challenges a Factual*



*Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence, and 37 C.F.R. 1.104(d)(2).*

**2. Dependent Claims 2-12 Patentable for at Least Reasons of Dependency from Independent Claim 1**

Claims 2-12 depend either directly or indirectly from Independent Claim 1. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 2-12 are patentable for at least the reasons why Independent Claim 1 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 2-12 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**C. Technical Material Cited by Examiner Does Not Show or Suggest the Text of Independent Claim 13 and Dependent Claims 14-21 as Presented Herein; Notice of Allowance of Same Respectfully Requested**

**1. Independent Claim 13**

**Independent Claim 13 recites as follows:**

"A method of identifying an item comprising:

detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and reading identifying information by interpreting the output."

As shown following, (1) Examiner has ignored several express recitations of Independent Claim 13 and (2) Examiner is interpreting McElhatton to "teach" at least a portion of the text of Independent Claim 13, but has not provided any objectively verifiable evidence supporting his interpretation.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 13 for any or all of the foregoing

reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 13 and Issue a Notice of Allowability for same.

**a) Examiner Has Ignored Several Express Recitations of Independent Claim 13 and Therefore Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 13**

As set forth above, Independent Claim 13 recites as follows: "A method of identifying an item comprising: (a) detecting at least one three-dimensional configuration with a penetrating imaging tool, the detecting at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and (b) reading identifying information by interpreting the output." <sup>10</sup>

Applicant respectfully points out, as shown following, that McElhatton does not recite as Examiner alleges. However, even if McElhatton did so recite, Applicant respectfully points out that, in violation of the MPEP standards on establishing a prima facie case of unpatentability, Examiner has ignored several express recitations of Applicant's claims and thus no prima facie case exists for at least that reason. For example, Clauses [a] and [b] of Independent Claim 13 recite "**detecting at least one three-dimensional configuration with a penetrating imaging tool, the detecting at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and (b) reading identifying information by interpreting the output.**" Thus, assuming for sake of argument that McElhatton did teach "an item comprising an outer part including at least one outer material ... that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration ... corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of a substantially empty cavity in the at least one outer material, or at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light," Applicant points out that no prima facie case of

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<sup>10</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

unpatentability exists in that Examiner has failed to adduce any objectively verifiable evidence, or argument based on objectively verifiable evidence, of a teaching to modify/combine the Examiner-alleged teachings to meet at least the foregoing-bolded claim recitations. Accordingly, even if McElhatton taught as alleged by Examiner, no prima facie case yet obtains in that Examiner has yet to put forth any objectively-verifiable evidence/argument based on same sufficient to meet a prima facie case. Accordingly, for at least these reasons, under the MPEP guidelines as set forth above, the Examiner-cited technical material does not establish a prima-facie case of the unpatentability of Independent Claim 13. Thus, Applicant respectfully asks Examiner to hold Independent Claim 13 allowable and to issue a Notice of Allowability of same.

As noted above, with respect to Clauses [a] and [b] of Independent Claim 13, Examiner has stated,<sup>11</sup> "McElhatton teaches an item comprising an outer part including at least one outer material ... that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration ... corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of a substantially empty cavity in the at least one outer material, or at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light." Applicant respectfully points out that Applicant has reviewed the McElhatton reference identified by Examiner, and so far as Applicant can discern, McElhatton does not recite a **"detecting at least one three-dimensional configuration with a penetrating imaging tool, the detecting at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and (b) reading identifying information by interpreting the output,"** such as is set forth in Clauses [a] and [b] of Applicant's Independent Claim 13.<sup>12</sup> Applicant points out that no prima facie case of unpatentability exists in that Examiner has ignored at least the foregoing-

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<sup>11</sup> Applicant points out for the record that Examiner has apparently not examined the recitations of Applicant's claims, but has instead appears to have ignored the express language of both Applicant's claims and the Examiner-cited technical material. Accordingly, Applicant respectfully points out for the record that Examiner has not established a prima facie case of the unpatentability of any pending claim for at least this reason. Notwithstanding the foregoing, Applicant demonstrates herein that even if Examiner had followed the MPEP examination guidelines, no prima facie case of unpatentability would be extant.

<sup>12</sup> Nor does McElhatton recite as Examiner alleges, for that matter; Applicant again points out that, in derogation of the MPEP guidelines, Examiner has apparently ignored the language of Applicant's Independent Claim 13.

bolded recitations of Independent Claim 13. Because Examiner ignored at least the foregoing bolded recitations of Independent Claim 13, Examiner has failed to adduce any objectively verifiable evidence, or argument based on objectively verifiable evidence, of a teaching to modify/combine the Examiner-alleged teachings to meet at least the foregoing-bolded claim recitations (again, Applicant stresses that this is because Examiner ignored several express recitations of Independent Claim 13). Accordingly, even if McElhatton taught as alleged by Examiner, no prima facie case yet obtains in that Examiner has yet to put forth any objectively-verifiable evidence/argument based on same sufficient to meet a prima facie case. Accordingly, for at least these reasons, under the MPEP guidelines as set forth above, the Examiner-cited technical material does not establish a prima-facie case of the unpatentability of Independent Claim 37. Thus, Applicant respectfully asks Examiner to hold Independent Claim 13 allowable and to issue a Notice of Allowability of same.

**b) Examiner is Interpreting McElhatton to "Teach" the Text of Independent Claim 13, But Does Not Support His Interpretation, Therefore The Examiner Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 13**

With respect to Independent Claim 13, Examiner has stated "McElhatton teaches an item comprising an outer part including at least one outer material (substrate 22) that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration (configuration of inks areas 46 and gap regions 48) corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of a substantially empty cavity in the at least one outer material, or at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light (col. 2, lines 27-30 and col. 3, lines 30-34)." *See Examiner's Office Action*, pp. 2-3 (20 August 2008). Applicant respectfully disagrees and traverses the rejection.

**(1) Examiner Has Put Forth No Evidence  
Supporting His Interpretation That McElhatton  
“Teaches” Recitations of Independent Claim 13**

Applicant respectfully points out that Applicant has reviewed the portions of McElhatton identified by Examiner, and so far as Applicant can discern, the Examiner-cited portions of McElhatton do not recite the text of Applicant's Independent Claim 13. Rather, the relevant portions of McElhatton recite as follows:

FIG. 1 shows an emblem 20 having a substrate 22 with a first or frontside 24 facing upwardly, and an opposite second or backside 26 facing downwardly. An ink pattern 28, FIG. 2, is printed on second or backside 26 to provide graphics, to be described. A transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23 preferably of polycarbonate, acrylic or styrene, preferably having a thickness of 0.005 to 0.007 inch.

Ink pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween. Ink regions 54 of ink layer 32 are in the noted second set of gap regions 56. Ink regions 52 of ink layer 31 are in the noted third set of gap regions 58. Ink regions 52 and 54 of each of ink layers 31 and 32 are in the first noted set of gap regions 48, FIG. 14. The substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15. Ink layer 32 has differing depths in base layer 23, including a first depth at ink areas 46, and a second different depth at gap regions 48. Base layer 23 has differing depths in molded transparent layer 30, including a first depth at the noted first depth of ink layer 32 at ink areas 46, and a second depth at the noted second depth of ink layer 32 at gap regions 48.

The differing depths provide embossed 3-D graphics, which are encapsulated by molded transparent layer 30 and viewable through the latter from above, FIGS. 1, 10.

This universal application of mold tooling is simple and cost effective. The embossed 3-D graphic is viewable from above in FIGS. 1, 10, 15, 16, 17, through transparent substrate 60, if used, and through molded transparent layer 30.

*See Detailed Description McElhatton, col. 1, lines 48-57; col. 2, lines 6-23, lines 27-30; and col. 3, lines 30-34.*

As can be seen from the foregoing, the examiner-identified portions of McElhatton do not recite the text of clauses (a) – (b) as recited in Independent Claim 13. For instance, clause (a) recites "detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool." Emphasis added. Nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[t]he substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15." (McElhatton, col. 1, lines 54-55). Clause (b) recites "reading identifying information by interpreting the output." Similarly, nowhere in McElhatton is there a recitation of this clause. Rather, col. 2, lines 36-46 recite "[i]nk pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween."

Applicant has reviewed the Examiner cited portions of McElhatton and is unable to locate a recitation of clauses (a) – (b) of Claim 13. Applicant further respectfully points out that the Examiner has provided no evidence or reason as to why the text of McElhatton should be interpreted to teach clauses (a) – (b) of Independent Claim 13 as the Examiner alleges.

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as teaching clauses (a) – (b) of Independent Claim 13.

With respect to Examiner assertions regarding the teachings of McElhatton, Applicant demonstrated above that the express recitations of McElhatton are not as Examiner alleges, and that Examiner has provided no evidence – let alone the preponderance of the evidence required -- to support Examiner assertions as to the factual conclusion as to what McElhatton "teaches." Accordingly, Applicant respectfully points out that in view of the foregoing, Examiner has presented no evidence that McElhatton teaches as asserted by Examiner. In addition, Applicant respectfully points out that even if Examiner's assertions regarding the teachings of McElhatton were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of McElhatton to the actual express language of Clauses [a] - [c] of Applicant's

Independent Claim 1. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 1 allowable and issue a Notice of Allowability of same.

**(2) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight; Applicant Requests Issuance of Notice of Allowability**

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as "teaching" something related to Independent Claim 13. Applicant respectfully points out that the Applicant's Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of McElhatton as set forth, it follows that Examiner is interpreting McElhatton through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding McElhatton are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 13 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner "teaches," Applicant infers that the Examiner is relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." *See, e.g., MPEP S 2144.03(C), If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

**2. Dependent Claims 14-21 Patentable for at Least Reasons of Dependency from Independent Claim 13**

Claims 14-21 depend either directly or indirectly from Independent Claim 13. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 14-21 are patentable for at least the reasons why Independent Claim 13 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 14-21 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**D. Technical Material Cited by Examiner Does Not Show or Suggest the Text of Independent Claim 22 and Dependent Claims 23-33 as Presented Herein; Notice of Allowance of Same Respectfully Requested**

**1. Independent Claim 22**

Independent Claim 22 recites as follows:

"A method of making an item, the method comprising:

forming at least one portion of the item from at least one structural material; and

integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information, the at least one three-dimensional configuration including at least one of

- (1) a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or
- (2) an identifying material substantially shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light."



As shown following Examiner is interpreting McElhatton to “teach” at least a portion of the text of Independent Claim 22, but has not provided any objectively verifiable evidence supporting his interpretation.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 22 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 22 and Issue a Notice of Allowability for same.

**a) Examiner is Interpreting McElhatton to Show/Suggest the Text of Independent Claim 22, But Does Not Support His Interpretation, Therefore The Examiner Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 22**

As set forth above, Independent Claim 22 recites as follows: "A method of making an item, the method comprising: (a) forming at least one portion of the item from at least one structural material; and (b) integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information, the at least one three-dimensional configuration including at least one of (1) a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or (2) an identifying material substantially shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light." <sup>13</sup>

**(1) Examiner Has Put Forth No Evidence Supporting His Interpretation That McElhatton “Teaches” Recitations of Independent Claim 22**

With respect to Independent Claim 22, Examiner has stated "McElhatton teaches ... a method of making an item, the method comprising: forming at least one portion of the item from at least one structural material; and integrally with said forming the at least one portion,

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<sup>13</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light." *See Examiner's Office Action*, p. 3 (20 August 2008). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of McElhatton identified by Examiner, and so far as Applicant can discern, McElhatton does not recite the text of Applicant's Independent Claim 22. Rather, the relevant portions of McElhatton recite as follows:

FIG. 1 shows an emblem 20 having a substrate 22 with a first or frontside 24 facing upwardly, and an opposite second or backside 26 facing downwardly. An ink pattern 28, FIG. 2, is printed on second or backside 26 to provide graphics, to be described. A transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23 preferably of polycarbonate, acrylic or styrene, preferably having a thickness of 0.005 to 0.007 inch.

Ink pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween. Ink regions 54 of ink layer 32 are in the noted second set of gap regions 56. Ink regions 52 of ink layer 31 are in the noted third set of gap regions 58. Ink regions 52 and 54 of each of ink layers 31 and 32 are in the first noted set of gap regions 48, FIG. 14. The substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15. Ink layer 32 has differing depths in base layer 23, including a first depth at ink areas 46, and a second different depth at gap regions 48. Base layer 23 has differing depths in molded transparent layer 30, including a first depth at the noted first depth of ink layer 32 at ink areas 46, and a second depth at the noted second depth of ink layer 32 at gap regions 48.

The differing depths provide embossed 3-D graphics, which are encapsulated by molded transparent layer 30 and viewable through the latter from above, FIGS. 1, 10.

This universal application of mold tooling is simple and cost effective. The embossed 3-D graphic is viewable from above in FIGS. 1, 10, 15, 16, 17, through transparent substrate 60, if used, and through molded transparent layer 30.

*See Detailed Description McElhatton, col. 1, lines 48-57; col. 2, lines 6-23, lines 27-30; and col. 3, lines 30-34.*

As can be seen from the foregoing, the examiner-identified portions of McElhatton do not recite the text of clauses (a) – (b) as recited in Independent Claim 22. For instance, clause (a) recites "forming at least one portion of the item from at least one structural material." Emphasis added. Nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[a] transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23..." (McElhatton, col. 1, lines 52-55). Emphasis added. Clause (b) recites "integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information, the at least one three-dimensional configuration including at least one of (1) a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or (2) an identifying material substantially shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light." Emphasis added. Similarly, nowhere in McElhatton is there a recitation of this clause. Rather, col. 2, lines 36-46 recite "[i]nk pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween"

Applicant has reviewed the Examiner cited portions of McElhatton and is unable to locate a recitation of clauses (a) – (b) of Claim 22. Applicant further respectfully points out that

Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 22 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner "teaches," Applicant infers that the Examiner is relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." *See, e.g., MPEP S 2144.03(C), If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

## **2. Dependent Claims 23-33 Patentable for at Least Reasons of Dependency from Independent Claim 22**

Claims 23-33 depend either directly or indirectly from Independent Claim 22. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 23-33 are patentable for at least the reasons why Independent Claim 22 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 23-33 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

## **E. Technical Material Cited by Examiner Does Not Show or Suggest the Text of Independent Claim 34 and Dependent Claims 35-36 as Presented Herein; Notice of Allowance of Same Respectfully Requested**

### **1. Independent Claim 34**

Independent Claim 34 recites as follows:

"A method of making an item, the method comprising:

the Examiner has provided no evidence or reason as to why the text of McElhatton should be interpreted to teach clauses (a) – (b) of Independent Claim 22 as the Examiner alleges.

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as teaching clauses (a) – (b) of Independent Claim 22.

With respect to Examiner assertions regarding the teachings of McElhatton, Applicant demonstrated above that the express recitations of McElhatton are not as Examiner alleges, and that Examiner has provided no evidence – let alone the preponderance of the evidence required -- to support Examiner assertions as to the factual conclusion as to what McElhatton “teaches.” Accordingly, Applicant respectfully points out that in view of the foregoing, Examiner has presented no evidence that McElhatton teaches as asserted by Examiner. In addition, Applicant respectfully points out that even if Examiner’s assertions regarding the teachings of McElhatton were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of McElhatton to the actual express language of Clauses [a] - [b] of Applicant’s Independent Claim 22. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 22 allowable and issue a Notice of Allowability of same.

**(2) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight; Applicant Requests Issuance of Notice of Allowability**

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as "teaching" something related to Independent Claim 22. Applicant respectfully points out that the Applicant’s Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of McElhatton as set forth, it follows that Examiner is interpreting McElhatton through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding McElhatton are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons.

forming at least one portion of the item from at least one structural material; and integrally with the forming the at least one portion, enclosing within the at least structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item, the void being defined by the at least one structural material."

As shown following, Examiner is interpreting McElhatton to "teach" at least a portion of the text of Independent Claim 34, but has not provided any objectively verifiable evidence supporting his interpretation.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 34 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 34 and Issue a Notice of Allowability for same.

**a) Examiner is Interpreting McElhatton to Show/Suggest the Text of Independent Claim 34, But Does Not Support His Interpretation, Therefore The Examiner Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 34**

As set forth above, Independent Claim 34 recites as follows: "A method of making an item, the method comprising: (a) forming at least one portion of the item from at least one structural material; and (b) integrally with the forming the at least one portion, enclosing within the at least structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item, the void being defined by the at least one structural material." <sup>14</sup>

**(1) Examiner Has Put Forth No Evidence Supporting His Interpretation That McElhatton "Teaches" Recitations of Independent Claim 34**

With respect to Independent Claim 34, Examiner has stated "McElhatton teaches ... a method of making an item, the method comprising: forming at least one portion of the item

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<sup>14</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

form at least one structural material; and integrally with the forming the at least one portion, enclosing within the at least structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item, the void being defined by the at least one structural material." *See Examiner's Office Action*, p. 3 (20 August 2008). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of McElhatton identified by Examiner, and so far as Applicant can discern, McElhatton does not recite the text of Applicant's Independent Claim 34. Rather, the relevant portions of McElhatton recite as follows:

FIG. 1 shows an emblem 20 having a substrate 22 with a first or frontside 24 facing upwardly, and an opposite second or backside 26 facing downwardly. An ink pattern 28, FIG. 2, is printed on second or backside 26 to provide graphics, to be described. A transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23 preferably of polycarbonate, acrylic or styrene, preferably having a thickness of 0.005 to 0.007 inch.

Ink pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween. Ink regions 54 of ink layer 32 are in the noted second set of gap regions 56. Ink regions 52 of ink layer 31 are in the noted third set of gap regions 58. Ink regions 52 and 54 of each of ink layers 31 and 32 are in the first noted set of gap regions 48, FIG. 14. The substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15. Ink layer 32 has differing depths in base layer 23, including a first depth at ink areas 46, and a second different depth at gap regions 48. Base layer 23 has differing depths in molded transparent layer 30, including a first depth at the noted first depth of ink layer 32 at ink areas 46, and a second depth at the noted second depth of ink layer 32 at gap regions 48.

The differing depths provide embossed 3-D graphics, which are encapsulated by molded transparent layer 30 and viewable through the latter from above, FIGS. 1, 10.

This universal application of mold tooling is simple and cost effective. The embossed 3-D graphic is viewable from above in FIGS. 1, 10, 15, 16, 17, through transparent substrate 60, if used, and through molded transparent layer 30.

*See Detailed Description McElhatton, col. 1, lines 48-57; col. 2, lines 6-23, lines 27-30; and col. 3, lines 30-34.*

As can be seen from the foregoing, the examiner-identified portions of McElhatton do not recite the text of clauses (a) – (b) as recited in Independent Claim 34. For instance, clause (a) recites "forming at least one portion of the item from at least one structural material." Emphasis added. Nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[a] transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23..." (McElhatton, col. 1, lines 52-55). Emphasis added. Clause (b) recites "integrally with the forming the at least one portion, enclosing within the at least structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item, the void being defined by the at least one structural material." Emphasis added. Similarly, nowhere in McElhatton is there a recitation of this clause. Rather, col. 2, lines 36-46 recite "[i]nk pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween"

Applicant has reviewed the Examiner cited portions of McElhatton and is unable to locate a recitation of clauses (a) – (b) of Claim 34. Applicant further respectfully points out that the Examiner has provided no evidence or reason as to why the text of McElhatton should be interpreted to teach clauses (a) – (b) of Independent Claim 34 as the Examiner alleges.

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as teaching clauses (a) – (b) of Independent Claim 34.

With respect to Examiner assertions regarding the teachings of McElhatton, Applicant demonstrated above that the express recitations of McElhatton are not as Examiner alleges, and



that Examiner has provided no evidence – let alone the preponderance of the evidence required -- to support Examiner assertions as to the factual conclusion as to what McElhatton “teaches.” Accordingly, Applicant respectfully points out that in view of the foregoing, Examiner has presented no evidence that McElhatton teaches as asserted by Examiner. In addition, Applicant respectfully points out that even if Examiner’s assertions regarding the teachings of McElhatton were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of McElhatton to the actual express language of Claims [a] - [b] of Applicant’s Independent Claim 34. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 34 allowable and issue a Notice of Allowability of same.

**(2) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight; Applicant Requests Issuance of Notice of Allowability**

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as “teaching” something related to Independent Claim 34. Applicant respectfully points out that the Applicant’s Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of McElhatton as set forth, it follows that Examiner is interpreting McElhatton through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding McElhatton are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 34 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner “teaches,” Applicant infers that the Examiner is relying on “personal knowledge” and/or is taking “official notice” of one or more factors to reach the factual conclusion of what the cited technical

material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." *See, e.g., MPEP S 2144.03(C), If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

**2. Dependent Claims 35-36 Patentable for at Least Reasons of Dependency from Independent Claim 34**

Claims 35-36 depend either directly or indirectly from Independent Claim 34. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 35-36 are patentable for at least the reasons why Independent Claim 34 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 35-36 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**F. Technical Material Cited by Examiner Does Not Show or Suggest the Text of Independent Claim 37 and Dependent Claims 38-42 as Presented Herein; Notice of Allowance of Same Respectfully Requested**

**1. Independent Claim 37**

Independent Claim 37 recites as follows:

"A method of forming a computer-readable representation of an item, the method comprising:

forming an outer surface computer-readable representation part including a representation of the outer surface of the item;

forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface; and

associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part."

As shown following, (1) Examiner has ignored several express recitations of Independent Claim 37 and (2) Examiner is interpreting McElhatton to "teach" at least a portion of the text of Independent Claim 37, but has not provided any objectively verifiable evidence supporting his interpretation.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 37 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 37 and Issue a Notice of Allowability for same.

**a) Examiner Has Ignored Several Express Recitations of Independent Claim 37 and Therefore Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 37**

As set forth above, Independent Claim 37 recites as follows: "A method of forming a computer-readable representation of an item, the method comprising: (a) forming an outer surface computer-readable representation part including a representation of the outer surface of the item; (b) forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface; and (c) associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part." <sup>15</sup>

With respect to Independent Claim 37, Examiner has stated<sup>16</sup> "McElhatton teaches ... a method of making an item, the method comprising: forming at least one portion of the item

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<sup>15</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

<sup>16</sup> Applicant points out for the record that Examiner has apparently not examined the recitations of Applicant's claims, but appears to have ignored the express language of both Applicant's claims and the Examiner-cited technical material. Accordingly, Applicant respectfully points out for the record that Examiner has not established a prima facie case of the unpatentability of any pending claim for at least this reason. Notwithstanding the foregoing, Applicant demonstrates herein that even if Examiner had followed the MPEP examination guidelines, no prima facie case of unpatentability would be extant.

form at least one structural material; and integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light." *See Examiner's Office Action*, pp. 2-3 (20 August 2008). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out, as shown following, that McElhatton does not recite as Examiner alleges. However, even if McElhatton did so recite, Applicant respectfully points out that, in violation of the MPEP standards on establishing a prima facie case of unpatentability, Examiner has ignored several express recitations of Applicant's claims and thus no prima facie case exists for at least that reason. For example, Clauses [a] - [c] of Independent Claim 37 recite **"forming an outer surface computer-readable representation part including a representation of the outer surface of the item," "forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface," and "associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part."** Thus, assuming for sake of argument that McElhatton did teach "a method of making an item, the method comprising: forming at least one portion of the item form at least one structural material; and integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light," Applicant points out that no prima facie case of unpatentability exists in that Examiner has ignored at least the foregoing-bolded recitations of Independent Claim 37. Because Examiner ignored at least the foregoing bolded recitations of Independent Claim 37, Examiner has failed to

adduce any objectively verifiable evidence, or argument based on objectively verifiable evidence, of a teaching to modify/combine the Examiner-alleged teachings to meet at least the foregoing-bolded claim recitations (again, Applicant stresses that this is because Examiner ignored several express recitations of Independent Claim 37). Accordingly, even if McElhatton taught as alleged by Examiner, no prima facie case yet obtains in that Examiner has yet to put forth any objectively-verifiable evidence/argument based on same sufficient to meet a prima facie case. Accordingly, for at least these reasons, under the MPEP guidelines as set forth above, the Examiner-cited technical material does not establish a prima-facie case of the unpatentability of Independent Claim 37. Thus, Applicant respectfully asks Examiner to hold Independent Claim 37 allowable and to issue a Notice of Allowability of same.

**b) Examiner is Interpreting McElhatton to Show/Suggest the Text of Independent Claim 37, But Does Not Support His Interpretation, Therefore The Examiner Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 37**

As set forth above, Independent Claim 37 recites in part: **"forming an outer surface computer-readable representation part including a representation of the outer surface of the item," "forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface," and "associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part."**

**(1) Examiner Has Put Forth No Evidence Supporting His Interpretation That McElhatton "Teaches" Recitations of Independent Claim 37**

As noted above, with respect to Clauses [a] - [c] of Independent Claim 37, Examiner has stated,<sup>17</sup> "McElhatton teaches ... a method of making an item, the method comprising: forming

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<sup>17</sup> Applicant points out for the record that Examiner has apparently not examined the recitations of Applicant's claims, but has instead appears to have ignored the express language of both Applicant's claims and the Examiner-

at least one portion of the item form at least one structural material; and integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light."

**(2) Examiner Has Put Forth No Evidence  
Supporting His Interpretation That McElhatton  
"Teaches" Recitations of Independent Claim 34**

Applicant respectfully points out that Applicant has reviewed the portions of McElhatton identified by Examiner, and so far as Applicant can discern, McElhatton does not recite the text of Applicant's Independent Claim 34. Rather, the relevant portions of McElhatton recite as follows:

FIG. 1 shows an emblem 20 having a substrate 22 with a first or frontside 24 facing upwardly, and an opposite second or backside 26 facing downwardly. An ink pattern 28, FIG. 2, is printed on second or backside 26 to provide graphics, to be described. A transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23 preferably of polycarbonate, acrylic or styrene, preferably having a thickness of 0.005 to 0.007 inch.

Ink pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween. Ink regions 54 of ink layer 32 are in the noted second set of gap regions 56. Ink regions 52 of ink layer 31 are in the noted third set of gap regions 58. Ink regions 52 and 54 of each of ink layers 31 and 32 are in the first noted set of gap regions 48, FIG. 14. The substrate is then exposed to UV radiation, FIG. 14, as above, to

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cited technical material. Accordingly, Applicant respectfully points out for the record that Examiner has not established a prima facie case of the unpatentability of any pending claim for at least this reason. Notwithstanding the foregoing, Applicant demonstrates herein that even if Examiner had followed the MPEP examination guidelines, no prima facie case of unpatentability would be extant.

UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15. Ink layer 32 has differing depths in base layer 23, including a first depth at ink areas 46, and a second different depth at gap regions 48. Base layer 23 has differing depths in molded transparent layer 30, including a first depth at the noted first depth of ink layer 32 at ink areas 46, and a second depth at the noted second depth of ink layer 32 at gap regions 48.

The differing depths provide embossed 3-D graphics, which are encapsulated by molded transparent layer 30 and viewable through the latter from above, FIGS. 1, 10.

This universal application of mold tooling is simple and cost effective. The embossed 3-D graphic is viewable from above in FIGS. 1, 10, 15, 16, 17, through transparent substrate 60, if used, and through molded transparent layer 30.

*See Detailed Description McElhatton, col. 1, lines 48-57; col. 2, lines 6-23, lines 27-30; and col. 3, lines 30-34.*

As can be seen from the foregoing, the examiner-identified portions of McElhatton do not recite the text of clauses (a) – (c) as recited in Independent Claim 37. For instance, clause (a) recites "forming **an outer surface computer-readable representation part including a representation of the outer surface of the item.**" Emphasis added. Nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[a] transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23..." (McElhatton, col. 1, lines 52-55). Emphasis added. Clause (b) recites ""**forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding** to identifying information that identifies the item, and **the at least one identifying surface being contained within the outer surface.**" Emphasis added. Similarly, nowhere in McElhatton is there a recitation of this clause. Rather, col. 2, lines 36-46 recite "[i]nk pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween." Clause (c) recites "**associating the outer surface**

**computer-readable representation part and the identifying surface computer-readable representation part."** Likewise, nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[t]he substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15."

Applicant has reviewed the Examiner cited portions of McElhatton and is unable to locate a recitation of clauses (a) – (c) of Claim 37. Applicant further respectfully points out that the Examiner has provided no evidence or reason as to why the text of McElhatton should be interpreted to teach clauses (a) – (c) of Independent Claim 37 as the Examiner alleges.

With respect to Examiner assertions regarding the teachings of McElhatton, Applicant demonstrated above that the express recitations of McElhatton are not as Examiner alleges, and that Examiner has provided no evidence – let alone the preponderance of the evidence required -- to support Examiner assertions as to the factual conclusion as to what McElhatton “teaches.” Accordingly, Applicant respectfully points out that in view of the foregoing, Examiner has presented no evidence that McElhatton teaches as asserted by Examiner. In addition, Applicant respectfully points out that even if Examiner’s assertions regarding the teachings of McElhatton were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of McElhatton to the actual express language of Clauses [a] - [b] of Applicant’s Independent Claim 37. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 37 allowable and issue a Notice of Allowability of same.

**(3) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight; Applicant Requests Issuance of Notice of Allowability**

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as "teaching" something related to Independent Claim 37. Applicant respectfully points out that the Applicant’s Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of McElhatton



as set forth, it follows that Examiner is interpreting McElhatton through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding McElhatton are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 37 allowable and issue a Notice of Allowability of same.

In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner "teaches," Applicant infers that the Examiner is relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." *See, e.g., MPEP S 2144.03(C), If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

## **2. Dependent Claims 38-42 Patentable for at Least Reasons of Dependency from Independent Claim 37**

Claims 38-42 depend either directly or indirectly from Independent Claim 37. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 38-42 are patentable for at least the reasons why Independent Claim 37 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 38-42 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

## **G. Technical Material Cited by Examiner Does Not Show or Suggest the Text of Independent Claim 43 and Dependent Claims 44-48 as Presented Herein; Notice of Allowance of Same Respectfully Requested**

### **1. Independent Claim 43**

Independent Claim 43 recites as follows:

"A method of manufacturing an item, the method comprising:

forming a computer-readable representation of the item, the computer-readable representation including a representation of at least one three-dimensional configuration, the at least one three-dimensional configuration corresponding to identifying information that identifies the item; and

producing the item using the computer-readable representation of the item, the item including

- (1) at least one structural material, and
- (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of
  - (a) a void within the at least one structural material, or
  - (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light."

As shown following, (1) Examiner has ignored several express recitations of Independent Claim 37 and (2) Examiner is interpreting McElhatton to "teach" at least a portion of the text of Independent Claim 37, but has not provided any objectively verifiable evidence supporting his interpretation.

Under the MPEP standards as set forth herein, Examiner has not met his burden to establish a prima facie case of the unpatentability of Independent Claim 37 for any or all of the forgoing reasons. Accordingly, Applicant respectfully requests that Examiner withdraw his rejections of Claim 37 and Issue a Notice of Allowability for same.

**a) Examiner Has Ignored Several Express Recitations of Independent Claim 43 and Therefore Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 43**

As set forth above, Independent Claim 43 recites as follows: "A method of manufacturing an item, the method comprising: (i) forming a computer-readable representation of the item, the computer-readable representation including a representation of at least one three-dimensional configuration, the at least one three-dimensional configuration corresponding to identifying information that identifies the item; and (ii) producing the item using the computer-readable representation of the item, the item including (1) at least one structural material, and (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void within the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light."<sup>18</sup>

With respect to Independent Claim 43, Examiner has stated "McElhatton teaches ... a method of making an item, the method comprising: forming at least one portion of the item form at least one structural material; and integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light." *See Examiner's Office Action*, pp. 2-3 (20 August 2008). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out, as shown following, that McElhatton does not recite as Examiner alleges. However, even if McElhatton did so recite, Applicant respectfully points out that, in violation of the MPEP standards on establishing a prima facie case of unpatentability, Examiner has ignored several express recitations of Applicant's claims and thus no prima facie

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<sup>18</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

case exists for at least that reason. For example, Clauses [i] and [ii] of Independent Claim 43 recite "(i) **forming a computer-readable representation of the item, the computer-readable representation including a representation of at least one three-dimensional configuration,** the at least one three-dimensional configuration corresponding to identifying information that identifies the item; and (ii) **producing the item using the computer-readable representation of the item,** the item including (1) at least one structural material, and (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void within the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light." Thus, assuming for sake of argument that McElhatton did teach "a method of making an item, the method comprising: forming at least one portion of the item from at least one structural material; and integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light," Applicant points out that no prima facie case of unpatentability exists in that Examiner has ignored at least the foregoing-bolded recitations of Independent Claim 43. Because Examiner ignored at least the foregoing bolded recitations of Independent Claim 43, Examiner has failed to adduce any objectively verifiable evidence, or argument based on objectively verifiable evidence, of a teaching to modify/combine the Examiner-alleged teachings to meet at least the foregoing-bolded claim recitations (again, Applicant stresses that this is because Examiner ignored several express recitations of Independent Claim 43). Accordingly, even if McElhatton taught as alleged by Examiner, no prima facie case yet obtains in that Examiner has yet to put forth any objectively-verifiable evidence/argument based on same sufficient to meet a prima facie case. Accordingly, for at least these reasons, under the MPEP guidelines as set forth above, the Examiner-cited technical material does not establish a prima-facie case of the unpatentability of Independent Claim 43.

Thus, Applicant respectfully asks Examiner to hold Independent Claim 43 allowable and to issue a Notice of Allowability of same.

**b) Examiner is Interpreting McElhatton to Show/Suggest the Text of Independent Claim 43, But Does Not Support His Interpretation, Therefore The Examiner Has Not Met His Burden to Establish a Prima Facie Case of Unpatentability for Independent Claim 43**

As set forth above, Independent Claim 43 recites in part: "forming an outer surface computer-readable representation part including a representation of the outer surface of the item," "forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface," and "associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part."

**(1) Examiner Has Put Forth No Evidence Supporting His Interpretation That McElhatton "Teaches" Recitations of Independent Claim 43**

As noted above, with respect to Independent Claim 43, Examiner has stated,<sup>19</sup> "McElhatton teaches ... a method of making an item, the method comprising: forming at least one portion of the item from at least one structural material; and integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or

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<sup>19</sup> Applicant points out for the record that Examiner has apparently not examined the recitations of Applicant's claims, but has instead appears to have ignored the express language of both Applicant's claims and the Examiner-cited technical material. Accordingly, Applicant respectfully points out for the record that Examiner has not established a prima facie case of the unpatentability of any pending claim for at least this reason. Notwithstanding the foregoing, Applicant demonstrates herein that even if Examiner had followed the MPEP examination guidelines, no prima facie case of unpatentability would be extant.

an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light."

**(2) Examiner Has Put Forth No Evidence  
Supporting His Interpretation That McElhatton  
"Teaches" Recitations of Independent Claim 43**

Applicant respectfully points out that Applicant has reviewed the portions of McElhatton identified by Examiner, and so far as Applicant can discern, McElhatton does not recite the text of Applicant's Independent Claim 43. Rather, the relevant portions of McElhatton recite as follows:

FIG. 1 shows an emblem 20 having a substrate 22 with a first or frontside 24 facing upwardly, and an opposite second or backside 26 facing downwardly. An ink pattern 28, FIG. 2, is printed on second or backside 26 to provide graphics, to be described. A transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23 preferably of polycarbonate, acrylic or styrene, preferably having a thickness of 0.005 to 0.007 inch.

Ink pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween. Ink regions 54 of ink layer 32 are in the noted second set of gap regions 56. Ink regions 52 of ink layer 31 are in the noted third set of gap regions 58. Ink regions 52 and 54 of each of ink layers 31 and 32 are in the first noted set of gap regions 48, FIG. 14. The substrate is then exposed to UV radiation, FIG. 14, as above, to UV harden ink pattern 28, followed by the noted cutting and trimming, and then molding as in FIGS. 7-9, to yield emblem 20a, FIG. 15. Ink layer 32 has differing depths in base layer 23, including a first depth at ink areas 46, and a second different depth at gap regions 48. Base layer 23 has differing depths in molded transparent layer 30, including a first depth at the noted first depth of ink layer 32 at ink areas 46, and a second depth at the noted second depth of ink layer 32 at gap regions 48.

The differing depths provide embossed 3-D graphics, which are encapsulated by molded transparent layer 30 and viewable through the latter from above, FIGS. 1, 10.

This universal application of mold tooling is simple and cost effective. The embossed 3-D graphic is viewable from above in FIGS. 1, 10, 15, 16, 17, through transparent substrate 60, if used, and through molded transparent layer 30.

*See Detailed Description McElhatton, col. 1, lines 48-57; col. 2, lines 6-23, lines 27-30; and col. 3, lines 30-34.*

As can be seen from the foregoing, the examiner-identified portions of McElhatton do not recite the text of Independent Claim 43. For instance, clause (i) recites "**forming a computer-readable representation of the item, the computer-readable representation including a representation of at least one three-dimensional configuration**, the at least one three-dimensional configuration corresponding to identifying information that identifies the item;" Emphasis added. Nowhere in McElhatton is there a recitation of this clause. Rather, McElhatton recites "[a] transparent layer 30 is molded on first or front side 24, and the noted graphics are viewable through such transparent layer. Substrate 22, FIG. 3, is provided by a thin film transparent base layer 23..." (McElhatton, col. 1, lines 52-55). Emphasis added. Clause (ii) recites "**producing the item using the computer-readable representation of the item**, the item including (1) at least one structural material, and (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void within the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light." Emphasis added. Similarly, nowhere in McElhatton is there a recitation of this clause. Rather, col. 2, lines 36-46 recite "[i]nk pattern 28, FIG. 14, is printed on ink layer 32 and includes the noted plurality of ink areas 46 separated by gap regions 48 therebetween. Ink layer 31 includes portions such as 52 in gap regions 48. Ink layer 32 includes portions such as 54 in gap regions 48. Ink layer 31, FIG. 12, has a plurality of ink regions 52 separated by a second set of gap regions 56 therebetween. Ink layer 32, FIG. 13, has a plurality of ink regions 54 separated by a third set of gap regions 58 therebetween."

Applicant has reviewed the Examiner cited portions of McElhatton and is unable to locate a recitation of Claim 43. Applicant further respectfully points out that the Examiner has

provided no evidence or reason as to why the text of McElhatton should be interpreted to teach Independent Claim 43 as the Examiner alleges.

With respect to Examiner assertions regarding the teachings of McElhatton, Applicant demonstrated above that the express recitations of McElhatton are not as Examiner alleges, and that Examiner has provided no evidence – let alone the preponderance of the evidence required -- to support Examiner assertions as to the factual conclusion as to what McElhatton “teaches.” Accordingly, Applicant respectfully points out that in view of the foregoing, Examiner has presented no evidence that McElhatton teaches as asserted by Examiner. In addition, Applicant respectfully points out that even if Examiner’s assertions regarding the teachings of McElhatton were supported, such would be of no moment in that Examiner has yet to connect the alleged teaching of McElhatton to the actual express language of Clauses [a] - [b] of Applicant’s Independent Claim 43. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 43 allowable and issue a Notice of Allowability of same.

**(3) Examiner Interpretation Appears to be Based on Inadvertent Impermissible Hindsight; Applicant Requests Issuance of Notice of Allowability**

Given that Applicant has shown, above, what McElhatton actually recites, the question thus naturally arises as to how Examiner saw McElhatton as "teaching" something related to Independent Claim 43. Applicant respectfully points out that the Applicant’s Application is the only objectively verifiable examiner-cited document of record that shows or suggests what Examiner purports the references to teach. From this and the express recitations of McElhatton as set forth, it follows that Examiner is interpreting McElhatton through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding McElhatton are untenable. Under the MPEP guidelines as set forth above, the cited art of record fails to establish a prima facie case of unpatentability for at least these reasons. Accordingly, for at least the foregoing reasons, Applicant respectfully requests that Examiner hold Independent Claim 43 allowable and issue a Notice of Allowability of same.



In the alternative and/or in addition to the foregoing, as Examiner has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of Examiner assertions regarding what the technical material cited by Examiner "teaches," Applicant infers that the Examiner is relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches." In view of the foregoing, if Examiner desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Examiner provide an affidavit or declaration setting forth objectively verifiable evidence in support of Examiner's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." *See, e.g.,* MPEP S 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

**2. Dependent Claims 44-48 Patentable for at Least Reasons of Dependency from Independent Claim 43**

Claims 44-48 depend either directly or indirectly from Independent Claim 43. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *See* 35 U.S.C. § 112 paragraph 4. Consequently, Dependent Claims 44-48 are patentable for at least the reasons why Independent Claim 43 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Dependent Claims 44-48 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**V. CONCLUSION**

Applicant may have during the course of prosecution cancelled and/or amended one or more claims. Applicant notes that any such cancellations and/or amendments will have transpired (i) prior to issuance and (ii) in the context of the rules that govern claim interpretation during prosecution before the United States Patent and Trademark Office (USPTO). Applicant notes that the rules that govern claim interpretation during prosecution form a radically different context than the rules that govern claim interpretation subsequent to a patent issuing. Accordingly, Applicant respectfully submits that any cancellations and/or amendments during the course of prosecution should be held to be tangential to and/or unrelated to patentability in

the event that such cancellations and/or amendments are viewed in a post-issuance context under post-issuance claim interpretation rules.

Insofar as that the Applicant may have during the course of prosecution cancelled/amended claims sufficient to obtain a Notice of Allowability of all claims pending, Applicant may not have during the course of prosecution explicitly addressed all rejections and/or statements in Examiner's Office Actions. The fact that rejections and/or statements may not be explicitly addressed during the course of prosecution should NOT be taken as an admission of any sort, and Applicant hereby reserves any and all rights to contest such rejections and/or statements at a later time. Specifically, no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended (e.g., with respect to any facts of which Examiner took Official Notice, and/or for which Examiner has supplied no objective showing, Applicant hereby contests those facts and requests express documentary proof of such facts at such time at which such facts may become relevant). For example, although not expressly set forth during the course of prosecution, Applicant continues to assert all points of (e.g. caused by, resulting from, responsive to, etc.) any previous Office Action, and no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended. Specifically, insofar as that Applicant does not consider the cancelled/unamended claims to be unpatentable, Applicant hereby gives notice that it may intend to file and/or has filed a continuing application in order prosecute such cancelled/unamended claims.

With respect to any cancelled claims, such cancelled claims were and continue to be a part of the original and/or present patent application(s). Applicant hereby reserves all rights to present any cancelled claim or claims for examination at a later time in this or another application. Applicant hereby gives public notice that any cancelled claims are still to be considered as present in all related patent application(s) (e.g. the original and/or present patent application) for all appropriate purposes (e.g., written description and/or enablement). Applicant does NOT intend to dedicate the subject matter of any cancelled claims to the public.

Applicant reserves the right to submit rebuttal evidence in the instance the Board of Patent Appeals and Interferences finds the Examiner met his burden in establishing a prima facie case of unpatentability. The fact that rebuttal evidence has not been explicitly provided during the course of prosecution should NOT be taken as an admission or waiver of any sort, and Applicant hereby reserves any and all rights to provide such rebuttal evidence at a later time.

The Examiner is encouraged to contact the undersigned by telephone at (402) 496-0300 to discuss the above and any other distinctions between the claims and the applied references, if desired. Also, if the Examiner notes any informalities in the claims, he is encouraged to contact the undersigned to expediently correct such informalities.

Respectfully submitted,

December 22, 2008

A handwritten signature in black ink, appearing to read 'Indhira A. LaPuma', is written over a horizontal line.

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